

**REMARKS****I. Allowable Subject Matter**

Applicants are appreciative of the indication that claims 3, 8-11, 16, 22 and 23 represent allowable subject matter. However, for the reasons set forth below, Applicants respectfully submit that all pending claims 1-3, 6-23 and 25-28 are in condition for allowance.

**II. Claim Rejections – 35 U.S.C. §103****A. Wong in view of Soloman**

Claims 1, 2, 6, 7, 12, 17-21 and 26-28 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over US 5,463,224 to Wong et al. ("Wong") in view of US 5,679,954 to Soloman ("Soloman").

In Paragraph 3 of the Office Action, the Examiner states that Wong does not explicitly describe a feeding means. For this purpose the Examiner relies on Solomon. According to the Examiner, it would have been obvious to one of ordinary skill in the art to modify Wong to include an automated feed means as taught by Soloman to transport samples to the analyzing position. For the following reasons of record, Applicants respectfully disagree.

**1. The holding parts of the claimed invention open "at" the analyzing position.**

In the Amendment filed 14 June 2006, claims 1, 19 and 27 were amended to clarify that the expression "analyzing position" does not refer to the first and second holding parts. Rather, the "analyzing position" is the place or location within the claimed apparatus at which the sample is analyzed and subjected to an optical measurement. Accordingly, it is an expressly recited feature of the claimed invention that the holding parts open to receive the sample to be analyzed and close "at" the analyzing position:

Claim 1.....wherein the holding parts open *at* the analysing position to receive the sample from the feeding means and close *at* the analysing position for analysis.

Wong does not disclose or suggest this feature of the claimed invention.

Wong teaches that the embodiment of Figure 7 may be used for a powder or solid sample (col. 4, lines 60-62; col. 8, line 66 to col. 9, line 1). In this embodiment, two sample holders 11 and 21 are clamped together by two screws 9 (col. 9, lines 1-3). Prior to clamping the upper sample holder 21 onto the lower sample holder 11, the sample 25 is placed onto the optical window 4a of the lower sample holder 11 (col. 9, lines 22-25). For Wong, the analyzing position is the place or location at which the completely assembled sample holder containing the sample is inserted into or mounted with a spectrophotometer (col. 3, lines 58-62; col. 6, lines 38-43). In view of common laboratory practice, Applicants submit that sample 25 is placed onto optical window 4a and that the sample holder containing the sample is completely assembled prior to insertion onto or mounting with the spectrophotometer at the analyzing position. Restrictions imposed by the actual design and structure of a spectrometer would preclude clamping the upper sample holder 12, e.g., by the insertion and/or tightening of screws 9, onto the lower sample holder 11 which was first mounted onto the spectrophotometer to receive the sample.

It is submitted, therefore, that Wong does not disclose or suggest the recited feature of the claimed invention wherein the holding parts open at the analyzing position to receive the sample (from the feeding means) and close at the analyzing position for analysis. Rather, the holding parts or sample holders 11 and 21 of Wong receive the sample and are assembled prior to insertion into or mounting at the analyzing position.

**2. Wong – Solomon combination fails to establish prima facie obviousness.**

The technical solution provided by Wong is a single use, disposable sample holder (col. 3, lines 46-47). The Examiner alleges that this inventive feature would not be destroyed by combining Wong with Solomon and automating the process of feeding the sample to the holder. The Examiner states that the modification would decrease the possibility of contamination by eliminating the need for a human operator to handle the sample before it is analyzed.

The following relevant disclosure by Solomon can be divided into two areas which will be addressed separately:

- (a) an automatic infrared system comprising a supply station 14 from which samples of pressed tablets are directed to conveyor 15, and

(b) the automatic detachment of the samples from the conveyor 15 to receptacle 4 through air jet 18 (col. 3, lines 13-16).

Specifically, conveyor 15 delivers each sample assisted by the air jet 18 to lower parts 21 of receptacle 4 which is automatically opened to contain one sample at a time (Fig. 3). Infrared optics sensor 19 is firmly attached to upper plate 20 of receptacle 4 (Fig. 4). Infrared fiber optics sensor 19 is aimed at the sample tablet 22 inside receptacle 4, which is supported by lower part 21. Tablet 22 is spectrophotoscopically analyzed. When completed, the lower parts 21 of receptacle 4 are automatically opened and the tested sample 22 enters the post-test objects storage 16 (col. 3, lines 26-34).

Applicants will now address the modification of Wong to include features (a) and (b) disclosed by Solomon to allegedly meet the claimed invention.

(a) an automatic infrared system comprising a supply station 14 from which samples of pressed tablets are directed to conveyor 15

Contrary to the Examiner's position, there would still be the need for manual operation even if one were to modify Wong to include supply station 14 and conveyor 15. Specifically, in accordance with a first embodiment of Wong (See Figs. 1-6), the operator would still be required to raise up film 6 to place a sample 25 onto the optical window 4 and then lower the film to cover the sample. The film 6 is manually pressed down to contact the sample (col. 8, lines 12-13). In accordance with the second embodiment of Wong (Fig. 7), the operator would still be required to clamp sample holders 11 and 21 together, e.g., with screws 9. Finally, any such modification of Wong would not change the fact that, contrary to the claimed invention, the holding parts or sample holders 11 and 21 receive the sample and are assembled prior to insertion into or mounting with the analyzing position. In other words, supply station 14 and conveyor 15 would be structurally separate elements from the actual spectrophotometer. There is no apparent logic or advantage in such a modification to Wong. In any event, such a modification does not suggest the claimed invention.

(b) the automatic detachment of samples from the conveyor to 15 to receptacle 4

If one were to consider the modification of Wong to include supply station 14, conveyor 15 and also receptacle 4 as disclosed by Solomon, then Applicants respectfully submit that such a modification would destroy the purpose of the invention disclosed by Wong. Receptacle 4 comprising upper 20 and lower 21 parts and also the fiber optics sensor 19 is a permanent structure of the Solomon system. The system is designed to measure one tablet sample at a time. Accordingly, based on its structure and components parts, receptacle 4 is reused with each sample. As such, Solomon is antithetical to the express purpose of Wong which is to conduct infrared spectroscopy with a single use, disposable sample holder.

In this regard, Applicants rely on the guidelines and case law set forth in the M.P.E.P.:

**2143.01 Suggestion or Motivation To Modify the References**

**V. THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE**

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

**VI. THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE**

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)

Relying on the M.P.E.P. and cited case law, Applicants submit that the modification of Wong to include supply station 14, conveyor 15 and receptacle 4 as disclosed by Solomon would render Wong unsatisfactory for its intended purpose (single use, disposable sample holder). Furthermore, such a modification would require substantial reconstruction and change the principle of operation of Wong.

In summary, withdrawal of the §103 rejection based on the combination of Wong and Solomon is requested:

- i. Wong does not disclose or suggest holding parts or sample holders 11 and 21 that open and close at the analyzing position, i.e., the sample holder containing the sample is assembled prior to insertion into or mounted with an infrared spectrophotometer;
- ii. human operation and handling of the sample are not eliminated by the combination of Wong and Solomon to include supply station 14 and conveyor 15;
- iii. the combination of Wong and Solomon to include supply station 14, conveyor 15 and receptacle 4 renders Wong unsatisfactory for its intended purpose; and
- iv. the combination of Wong and Solomon would change the principle of operation disclosed by Wong.

**B. Wong in view of Solomon and Schilling**

Claims 13-15 and 25 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over the combination of Wong, Solomon and DE 44 41 686 ("Schilling").

Schilling is cited for the alleged disclosure of an on-line sample receiver which provides a feeder wheel with samples. The Examiner concludes that it would have been obvious to combine Wong, Solomon and Schilling because use of a sample receiver would (1) ensure that a constant supply of tablets to be tested are always available and (2) lend itself to in-line sampling.

Schilling does not overcome the deficiencies of Wong and Solomon as discussed in the preceding section. Specifically, modification of Wong to include the feeding means of Solomon and the sample receiver of Schilling would destroy the intent, purpose and function of Wong which is to use a sample holder that is disposable and suitable as a single use. Furthermore, the single use and disposable nature of Wong is clearly not intended for in-line sampling. In accordance with Wong, the sample holder is manually assembled for mounting onto a spectrometer to present a sample for spectroanalysis. After the procedure, the sample holder and sample are then discarded and the procedure, i.e., assembly and mounting, is repeated with the next sample. No reasonable or permissible interpretation of Wong properly lends itself to a

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modification of that reference to include the feeding means of Soloman and the sample receiver of Schilling for in-line sampling.

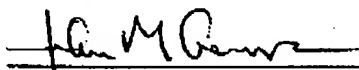
For all of the foregoing reasons and the relevant case law, Applicants submit that a *prima facie* case of obviousness has not been established. Withdrawal of the §103 rejection of claims 13-15 and 25 in view of the combination of Wong, Soloman and Schilling is requested.

### CONCLUSION

Applicants submit that claims 1-3, 6-23 and 25-28 are in condition for allowance, which action is earnestly solicited. The Commissioner is hereby authorized to charge Deposit Account No. 23-1703 in the event that any fee is required in connection with this communication.

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Respectfully submitted,



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